



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,393	10/07/2003	Arthur G. Taveras	OC01643K1	5744

24265 7590 03/15/2006

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
2000 GALLOPING HILL ROAD
KENILWORTH, NJ 07033-0530

EXAMINER

SOLOLA, TAOFIQ A

ART UNIT	PAPER NUMBER
----------	--------------

1626

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/680,393	Applicant(s) TAVERAS ET AL.	
	Examiner Taofiq A. Solola	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-67,70-73,86-93,112-119 and 132 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-67,70-73,86-93,112-119 and 132 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1626

Claims 1-67, 70-73, 86-93, 112-119, 132 are pending in this application.

Claims 68-69, 74-85, 94-111, 120-131 are cancelled.

RESTRICTION REQUIREMENT

As requested by Applicant, claims 86-93, 112-119, 132 are now rejoined with the elected invention. Applicant should note that such rejoinder is deemed an amendment.

Status of Claims

The Office has reviewed the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention encompasses all compounds within the scope of the claims, which fall into the same class and subclass as the elected compound, but may include additional compounds, which fall in related subclasses. Examination of the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common classification results in the following:

In formula I, A is a ring as defined in claim 1 but cannot directly attach to N. There must be an optionally substituted -CH₂- between ring A and N. Ring B is as defined in claim 1, but limited to those attached directly to N. R₁-R₄₀, g, and any other substituents are as defined in claim 1. As a result of the election and the corresponding scope of the invention identified herein, the remaining subject matter of claims 1-67, 70-73, 86-93, 112-119, 132 are withdrawn from further consideration by the Examiner, under 37 CFR § 1.142(b), as being drawn to a non-elected subject matter. The withdrawn compounds are patentably distinct from the examined invention as they differ in structure and element and would require a separate search. In

Art Unit: 1626

addition, a reference, which anticipates the examined invention, would not render obvious the non-elected subject matter.

The amendment filed 1/19/06 fails to conform to the allowable subject matter defined above. Such is deemed an inadequate response. Applicant should revisit the amendment with a view of putting the invention in condition for allowance. Applicant may call the Examiner should it need be.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 86-93, 112-119 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims lack adequate support in the specification for the following reasons. By deleting the claims the rejection would be overcome.

The assays on pages 137-143 have no specific results, no discussion and/or explanation of the results and their relationship with each claimed utility. The following general statement, page 143, fails to establish any nexus between the compounds and any of the claimed utilities

There were compounds of this invention that had an EC_{50} of $<10\mu M$. The compound of Example 2065 had an EC_{50} of 13nM, the compound of Example 2066 had an EC_{50} of 16nM, the compound of Example 2105 had an EC_{50} of 3nM, and the compound of Example 2106 had an EC_{50} of 12nM.

Art Unit: 1626

The following statement, page 2, appears speculative and the specification fails to disclose how Arenber et al., demonstrate antitumor antibody for IL-8.

chemotaxis. Thus, these chemokines probably induce chemotaxis of endothelial cells toward their site of production in the tumor. This may be a critical step in the induction of angiogenesis by the tumor. Inhibitors of CXCR2 or dual inhibitors of CXCR2 and CXCR1 will inhibit the angiogenic activity of the ELRCXC chemokines and therefore block the growth of the tumor. This anti-tumor activity has been demonstrated for antibodies to IL-8 (Arenberg et al. 1996 J Clin Invest 97 p. 2792-2802), ENA-78 (Arenberg et al. 1998 J Clin Invest 102 p. 465-72), and GRO α (Haghnegahdar et al. J. Leukoc Biol 2000 67 n. 53-62).

The specification also cited several journals at the bottom of page 1 as implicating chemokines in a wide range of acute and chronic inflammatory disorders. However, these and other journals are not incorporated by reference in accordance with the MPEP, which states as follows:

A mere reference to another application, publication or patent is not an incorporation of anything therein into the application containing such reference for the purpose of satisfying the requirement of 35 USC 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). Particular attention should be directed to the subject matter and the specific portions of the referenced document where the subject matter being incorporated may be found. MPEP 608.01(p).

If the document is a pending US application: prior to allowance of an application that incorporates essential material by reference to a pending US application, if the referenced application has not been published or issued as a patent, applicant is required to amend the disclosure of the referencing application to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating the amendment consists of the same material incorporated by reference in the referencing application. MPEP 608.01(p).

Art Unit: 1626

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 86-93, 112-119 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 86-93, 112-119 are indefinite for reasons set forth above under 35 USC 112, first paragraph. See the Examiner's suggestion above.

The term "example ###" in every occurrence in claim 132 renders the claim indefinite. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 8, 29, 33, 132 are rejected under 35 U.S.C. 102(b) as being anticipated by Schostarez et al., Bioorg. Med. Chem. Letters, (1996), Vol. 6, No. 18, pages 2187-2192.

Schostarez et al., disclose compounds 8c-9r and 1 in Table 1. See also paragraph 1, page 2190.

Claims 1-2, 8, 29, 132 are rejected under 35 U.S.C. 102(b) as being anticipated by Martinez et al., J. Heter. Chem. (1998), Vol. 35, pages 297-300.

Martinez et al., disclose compound 10 on page 298.

Art Unit: 1626

Applicant's arguments filed 1/19/06 have been fully considered but they are not persuasive. Applicant asserts the claims as amended are no longer anticipated by the prior arts. This is not persuasive because the claims are still anticipated by the prior arts.

Objection

Claims 1-67, 70-73, 86-93, 112-119, 132 are objected to for containing non-elected subject matter.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1626

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read 'Taofiq Solola', is written over a horizontal line.

**TAOFIQ SOLOLA
PRIMARY EXAMINER**

Group 1626

March 8, 2006